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In re Application of  
Roger P. Jackson  
Application No. 10/649,412  
Filing Date: 08/27/2003  
Attorney Docket No. 10,321

: DECISION ON PETITION  
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the Request for Reconsideration of Petition for Modification of Claim of Priority, filed January 18, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the concurrently filed Amendment. The petition is properly treated as a petition under 37 CFR 1.78(a)(3)

The petition is **DISMISSED**.

**Background**

Applicant filed a petition to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to prior-filed nonprovisional Application Nos. 09/729,600, filed December 4, 2000, which issued as U.S. Patent No. 6,440,170 on August 27, 2002, and 09/644,722, filed August 23, 2000, which issued as U.S. Patent No. 6,666,888 on December 23, 2003, said claim was set forth in an Application Data Sheet ("ADS").

The petition was dismissed in a Decision mailed December 8, 2006. The Decision dismissing the petition informed Applicant that 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain... the relationship between the applications [to wit] - whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application.

The Decision also informed Applicant that copendency does not exist between the above-identified application, and Application No. 09/729,600, for which the benefit is sought, because Application No. 09/729,600, filed December 4, 2000, issued as U.S. Patent No. 6,440,170 on August 27, 2002, which is one (1) year before the above-identified application was filed.

The present renewed petition

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The Amendment has been corrected to properly state the relationship of the applications, however, similar to the ADS filed with the June 6, 2005 petition, the amendment is still not acceptable as drafted since copendency does not exist between the above-identified application, and Application No. 09/729,600, for which the benefit is sought. Application No. 09/729,600, filed December 4, 2000, issued as U.S. Patent No. 6,440,170 on August 27, 2002, which is one (1) year before the above-identified application was filed. The above-identified application was filed on August 27, 2003. The statute at 35 U.S.C. § 120 permits a continuing application to claim the benefit of the filing date of a copending, previously filed, parent application provided there is inventorship overlap between the continuing application and the parent application. Here, the application for which the benefit is sought, 09/729,600, issued as a patent one year before the above-identified application was filed. As such, there is no copendency between the applications.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters is required. Applicant is also reminded that, if an amendment to the specification, or an application data sheet (ADS), is submitted in an application under final rejection, the amendment or ADS must be in compliance with 37 CFR 1.116. The amendment or ADS filed in an application under final rejection will not be entered as a matter of right. See MPEP 714.12 and 714.13. Therefore, applicants should consider filing a request for continued examination (RCE) (including fee and submission) under 37 CFR 1.114 with the petition to accept an unintentionally delayed benefit claim, the surcharge, and an amendment that adds the proper reference to the first sentence of the specification or an ADS.

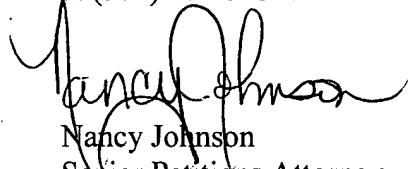
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Any questions concerning this matter may be directed to Senior Petitions Attorney Derek Woods  
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